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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,568	03/11/2002	Jonathan Mark Bentley	040283-0195	4962

22428 7590 02/24/2003  
FOLEY AND LARDNER  
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WASHINGTON, DC 20007

EXAMINER	
SMALL, ANDREA D SOUZA	
ART UNIT	PAPER NUMBER

1626  
DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/009,568	<b>Applicant(s)</b> BENTLEY ET AL.
	<b>Examiner</b> Andrea D Small	<b>Art Unit</b> 1626
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 12/24/03.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-9,11-15,18-22,25-27 and 29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9,11,13,14,18-20,25,27 and 29 is/are rejected.

7) Claim(s) 12,15,21,22 and 26 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### *I. Applicant's Response:*

Applicant's response filed 12/24/2003 has been received and entered as paper no. 8.

### *II. Amendments:*

- (a) Claim 10 and 30 have been cancelled.
- (b) Claim 1 has been amended to limit the recitation of the A moiety to 5 membered partially unsaturated carbocyclic or heterocyclic moiety.

Thus pending claims are 1-9, 11-15, 18-22, 25-27 and 29.

### *III. Remarks:*

- (a) Rejection under 35 USC 112, second: Cancellation of claim 30 has rendered the rejection moot.
- (b) Rejections under 35 USC 103(a): Amendment of claim 1 limiting said claim to the recitation as cited above has overcome said rejections.
- (c) Objections: the objections to claim 10 and 11 have been overcome.
- (d) Indicated allowable subject matter: The indication of allowable subject matter has been withdrawn in view of the rejections that follow.

### *IV. New Rejections:*

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 11, 13-14, 18-20, 25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto, et al.

Applicant's claims relate to pharmaceutically active indole compounds that are useful in treating CNS disorders.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Okamoto, et al teach pharmaceutically active indole compounds that are useful in treating CNS disorders, specifically where Applicants R4 or R7 is hydrogen or halogen; R5 and R6 is hydrogen; R3 is hydrogen; R1 and R2 is hydrogen and A is a five membered partially unsaturated carbocyclic ring. See abstract formula I, RN#s: 36856-42-5 and 36856-43-6, also see reference provided formula I.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the prior art and the instant claims is that the prior art teaches a hydrogen substituted at the R3 position, whereas the instant claims recite an alkyl moiety at the R3 position, thus making the difference one of a hydrogen v. methyl.

Finding of prima facie obviousness---rationale and motivation (MPEP §2142-2413)

However, it would have been prima facie obvious at the time of the filing of the instant application to modify the prior art compounds taught by Okamoto by substituting a methyl for hydrogen at the R3 position, with the motivation of preparing additional compounds useful in treating CNS disorders.

*Objections*

- (a) Claims 18-22 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Instantly, claims 18-22 depend from a later occurring claim, i.e., claim 25, thus fail to further limit a *previous* claim.
- (b) Claims 12, 15, 26, 21 and 22 are objected to as being dependent on rejected base claims and would appear allowable if rewritten in independent form.

*V. Salutation:*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

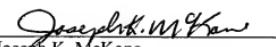
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive

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data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
February 14, 2003

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626  
Technology Center 1